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Paper No. 4

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OFFICE OF PETITIONS

In re Application of
Jenny
Application No. 10/085,695
Filed: February 28, 2002
Attorney Docket No. 1015-02
For: PROCESS TO REMOVE ORGANIC
IMPURITIES FROM BAYER PROCESS LIQUOR
USING OZONE

DECISION REFUSING
STATUS UNDER
37 CFR 1.47(b)

This is in response to the petition under 37 CFR 1.47(b), filed October 15, 2002 (certificate of mailing date October 8, 2002).

The petition is dismissed.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

The above-identified application was filed on February 28, 2002 without an executed oath or declaration. Accordingly, on April 8, 2002, a "Notice to File Missing Parts of Nonprovisional Application" was mailed, requiring an executed oath or declaration and a surcharge for its late filing.

In response, on October 15, 2002 (certificate of mailing date October 8, 2002), a petition for a four month extension of time and required fee, the surcharge, and the instant petition were filed. The petition sets forth the last known address of the non-signing inventor, Mr. Rudolf Jenny, and explains that Mr. Jenny approved the application papers in February 2002, but did not respond to the subsequent multiple requests that he sign the declaration for the patent application.

A grantable petition under 37 CFR 1.47(b) requires:

- (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration;
- (2) an acceptable oath or declaration;
- (3) the petition fee;
- (4) a statement of the last known address of the non-signing inventor;
- (5) proof of proprietary interest; and
- (6) proof of irreparable damage.

Applicant lacks item (1), (2), (5) and (6) set forth above.

As to item (1), Applicant has failed to establish that the inventor has refused to sign the declaration. The proof of the pertinent events should be made by a statement of someone with first hand knowledge of the events. Applicant allegedly reviewed the patent application in February 2002. At some later time, petitioner asked Mr. Jenny to sign a declaration and assignment for the application. The petition states, "The attorney who filed the application immediately thereafter requested a signed Declaration and Assignment." The Office cannot ascertain when the request to sign the declaration was made in relation to when Mr. Jenny reviewed the application. The e-mail exhibit between Joseph Giannone and Rudolf Jenny is not clear as to the title of the "last patent-version" that was reviewed.

Mr. Jenny's signature on the Declaration would obligate him, under penalty of "fine or imprisonment, or both" to particulars to which Mr. Jenny can only attest after having had the opportunity to review the subject patent application. If months transpired between his reading of the application and the request to sign the declaration, Mr. Jenny might not have had sufficient memory of the details of the application to join in the application. Mr. Jenny must have the opportunity to review the application contemporaneously, or at a point close in time to the presentation of the declaration for signature.

The attorney (Mr. Giannone?) who presented Mr. Jenny with the application and subsequently attempted to obtain a signed declaration from Mr. Jenny should provide a statement as to when these events transpired. If these events occurred close in time to each other, then petitioner will have proved the inventor refused to sign the declaration. The affidavit or declaration of facts must be signed, where at all possible, by a person having *firsthand knowledge* of the facts recited therein. Statements based on hearsay will not normally be accepted. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

If the review of the application and the presentation of the declaration for signature occurred far apart in time from each other, petitioner must send Mr. Jenny a copy of the as filed above-identified application with a request that the sign the enclosed declaration. See MPEP 409.03(d). If Mr. Jenny does not respond, then petitioner will establish refusal.

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 still has not been presented. There is no declaration in the application file. An oath or declaration in compliance with 37 CFR 1.63 and 1.64 signed by the Rule 1.47 applicant on behalf of Inventor Jenny is REQUIRED. See MPEP 409.03(b). The declaration must include information for Mr. Jenny and for the individual signing the declaration on behalf of Ozonia A.G.. The Office requires a declaration listing the inventor and the signer's name, title (if any), the address where he/she normally receives mail, his/her residence, and his/her citizenship. As stated in the MPEP 409.03(b), where an oath is signed by a registered attorney on behalf of a corporation, either proof of the attorney's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or the attorney may simply state that he is authorized to sign on behalf of the corporation.

As to item (5), Rule 47 applicant failed to show or provide proof that Ozonia A. G., has sufficient proprietary interest in the subject matter to justify the filing of the application (see MPEP 409.03(f)). Acceptable proof would include a copy of the employment agreement between the non-signing inventor and the Rule 47(b) applicant, a copy of an assignment agreement showing that the invention disclosed in the application is assigned to the Rule 47(b) applicant, or a legal memorandum signed by an attorney familiar with the law of the jurisdiction stating that a court of competent jurisdiction would by the weight of authority in that jurisdiction award the title of the invention to the Rule 47(b) applicant;

As to item (6), Rule 47 applicant failed to provide proof of irreparable damage (see MPEP 409.03(g)). A statement by Rule 47 applicant that the filing is necessary to preserve the rights of the parties would be sufficient.

Pursuant to petitioner's authorization, deposit account no. 13-3405 will be charged the \$130.00 petition fee.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By facsimile: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA 22202

Telephone inquiries should be directed to the undersigned at (703) 308-6712.



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